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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,431	04/30/2001	Ari Rosenberg	12031/1	4587
7590	05/23/2005		EXAMINER	
Shawn W. O'Dowd KENYON & KENYON Suite 600 333 West San Carlos Street San Jose, CA 95110			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	
DATE MAILED: 05/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/846,431	ROSENBERG, ARI
	Examiner Arthur Duran	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-27 have been examined.

Response to Amendment

2. The Amendment filed on 1/13/05 is sufficient to overcome the Horstmann reference. A new prior art reference has been added to the 35 USC 103 rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. §103(a) as being obvious over Horstmann US 6,285,985 (9/4/2001) [US f/d: 4/3/1998] (herein referred to as "Horstmann") in view of Gerace (5,848,396) in view of Blaser (6,757,661).

As per claim 1, Horstmann (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewers; recording an action taken by at least one of said viewers in response to said advertising message; and providing additional exposure of said advertising message based on said action."

Horstmann lacks an explicit recitation of claim 1 even though Horstmann implicitly shows all elements and limitations of claim 1.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 1, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 1, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement serve and to display them to the user. . . .*" (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

As per claim 2, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewers; recording a plurality of actions taken by ones of said viewers in response to said advertising message; and providing additional exposure of said advertising message to said plurality of viewers based on said plurality of actions."

Horstmann lacks an explicit recitation of claim 2 even though Horstmann implicitly shows all elements and limitations of claim 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 2, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 2, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement serve and to display them to the user. . . .*" (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

As per claim 3, Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows "A method for the presentation of advertisements, comprising: providing exposure of an advertising message to a plurality of viewer computers over a computer network; recording at said server a plurality of actions entered into ones of said viewer computers, said actions made in response to said advertising message; [and] providing bonus exposure of said advertising message to said plurality of viewer computers based on said plurality of actions."

Horstmann lacks an explicit recitation of claim 2 even though Horstmann implicitly shows all elements and limitations of claim 2.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Horstman (the ABSTRACT; FIG. 1, FIG.

4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all the elements and limitations of claim 3, and it would have been obvious to modify and interpret the disclosure of Horstmann cited above as implicitly showing all of the elements and limitations of claim 3, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement serve and to display them to the user. . . .*" (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . . .*" (See Horstmann (col. 2, ll. 5-10)).

As per claims 4-7, Horstmann shows the method of claim 3 and subsequent base claims depending from claim 3.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 2-7.

Horstmann lacks explicit recitation of some elements of claims 2-7, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 2-7 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 2-7 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all

of the elements and limitations of claims 2-7, because modification and interpretation of the cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement serve and to display them to the user. . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are varied to retain the interest of the user. . .*” (See Horstmann (col. 2, ll. 5-10)).

Independent claim 8 is rejected for substantially the same reasons as independent claim 3.

As per claims 9-12, Horstmann shows the method of claim 8 and subsequent base claims depending from claim 8.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 9-12.

Horstmann lacks explicit recitation of some elements of claims 9-12, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 9-12 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 9-12 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and limitations of claims 9-12, because modification and interpretation of the

cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement serve and to display them to the user. . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are varied to retain the interest of the user. . .*” (See Horstmann (col. 2, ll. 5-10)).

Independent claim 13 is rejected for substantially the same reasons as independent claim 8.

As per claims 14-17, Horstmann shows the method of claim 13 and subsequent base claims depending from claim 13.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 14-17.

Horstmann lacks explicit recitation of some elements of claims 14-17, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 14-17 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 14-17 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all of the elements and limitations of claims 14-17, because modification and

interpretation of the cited disclosure of Horstmann would have provided means to “*retrieve advertisements from an advertisement serve and to display them to the user. . .*” (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the “*advertisements are varied to retain the interest of the user. . .*” (See Horstmann (col. 2, ll. 5-10)).

Independent claim 18 is rejected for substantially the same reasons as independent claim 13.

As per claims 19-27, Horstmann shows the method of claim 18 and subsequent base claims depending from claim 18.

Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows all elements and limitations of claims 19-27.

Horstmann lacks explicit recitation of some elements of claims 19-27, even though Horstmann implicitly shows same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of dependent claims 19-27 were notoriously well known and expected in the art at the time of the invention, because it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure Horstman (the ABSTRACT; FIG. 1, FIG. 4; col. 2, ll. 1-40; col. 3, ll. 60-67; and whole document) implicitly shows the elements and limitations of claims 19-27 which are not explicitly recited in Horstman; and it would have been obvious to modify and interpret the disclosure of Horstman cited above as implicitly showing all

of the elements and limitations of claims 19-27, because modification and interpretation of the cited disclosure of Horstmann would have provided means to "*retrieve advertisements from an advertisement serve and to display them to the user. . .*" (see Horstmann (col. 2, ll. 1-10)), based on the motivation to modify Horstmann where the "*advertisements are varied to retain the interest of the user. . .*" (See Horstmann (col. 2, ll. 5-10)).

Additionally, in regards to the independent claims and their subsequent dependent claims, Gerace discloses providing a predetermined number of advertising impressions (Fig. 5b and col 15, lines 11-20 and below):

"(51) Each sponsor has one or more ad packages maintained by respective Ad Package Objects 33b of the sponsor. In each Ad Package Object 33b (FIG. 5b) there is indicated the sponsor ID, start and end dates and times, and pricing of the ad packages. The pricing may be dependent on the number of times the ad is viewed by users (i.e., a "hit"), number of times a user selects to view more information from the ad (i.e., a "click through") and/or the number of times an actual order is generated. Pricing by the number of hits and number of click throughs by exact numbers or maximum numbers is indicated in the Ad Package Object 33b. Thus Ad Package Objects 33b serve as billing entities for the program 31 administrator. Also Ad Package Object 33b records the number of hits and click throughs as tracked/monitored during user operation of program 31" (col 12, lines 6-21).

Gerace further discloses that additional number of advertising impressions are shown, beyond a predetermined number, based on the actions or responses of the user:

“(87) To ensure that sponsors achieve the optimal result from the ads they place, program 31 combines regression analysis with the above weighting technique to achieve real-time, automatic optimization as discussed previously. Under this auto-targeting system, an ad package is shown to general users. After a large number (e.g., 10,000) hits, program 31 runs a regression on a subject Ad Package Object 33b to see what characteristics are important, and who (type of user profile) the ad appeals to most. Program 31 then automatically enters weighting information based on that regression to create a targeted system and runs the advertisement (Ad Package Object 33b) again in front of this new targeted group. Program 31 then runs a regression every 10,000 hits, for example, including a group of 500 general people as a control, and adjusts the weighting. This continues until the Ad Package is exhausted (i.e., the number of hits and click throughs are achieved)” (col 18, lines 10-26).

Also, Blaser discloses additional displays of an advertisements based on the success of prior displays of that advertisement:

“(21) In certain circumstances, the ad server automatically transmits certain advertisements for immediate display in real time. In one such circumstance, the ad server determines whether any advertisements are exhibiting a good response from users of a given demographic category. If the advertisement is receiving a good response from users of a given demographic category, then the ad server automatically causes the advertisement to be displayed to users of a similar demographic category. Advertisements that are exhibiting a poor performance with users may also be given special attention. Such advertisements are increased in rotation or prominently displayed to the user in an attempt to generate user response to the advertisement (col 3, lines 46-60);

(81) Strong performance is just one criterion for transmitting an advertisement as a real time advertisement" (col 15, lines 15-19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's ad packages with a predetermined number of advertisement exposures and Blaser's displaying that ads that achieve ad success to Horstmann's displaying ads to retain the interest of the user. One would have been motivated to do this in order to present the ads that are successful with more frequency and thus attain higher ad response.

Response to Arguments .

3. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Please note the additional citations and prior art added at the section beginning with, "Additionally, in regards to the independent claims and their subsequent dependent claims, Gerace discloses providing. . .".

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a) Koeppel (6,477,575) discloses showing advertisements based on the success of prior displays of that advertisement:

“(53) Accordingly, Web server 110 may automatically adjust content rendered on the Web page previously rendered at client nodes 150. Providers controlling the Web server 110 may test the success of certain content or content rules on a customized and dynamic basis. That is, the provider of Web server 110 may program middleware program 112 to adjust the content to test new changes in attributes, or entirely new content, on an automatic basis using the content rules stored in data store 130 and the results of analytical program 115;

(56) Assume for this example, that the amount of time third version 440 was displayed was a criteria for analysis defined in the analytical program rules executed by analytical program 115. In the above example, the plurality of users monitored did not satisfy predefined conditions for a successful rendering of the third version 440, because as defined in the analytical program rules, within ten seconds the users "clicked-through" to another link and ignored versions 440,420 and 425 displayed in the center of Web page 300. Accordingly, results reflecting this analysis would be generated by analytical program 115, and in response to these analysis results analytical program 115 may redefine a content rule stored in data store 130. In this case, data store 130 includes a plurality of sufficient predefined rules and content, and no changes are made to content rules stored data store 130;

(59) As a result, the present invention allows providers to perform automatic dynamic market testing. Methods, systems and articles of manufacture consistent with present invention enable users located at client nodes 150, to not only be targeted for advertising, but to also utilize the users' response for evaluating the success of particular rendered content. The dynamic market analysis performed by middleware program 112 enable Web server 110 to automatically adjust served content based on responses from users, in a "real-time" and "hands-free" closed loop operation, which is an advantage over conventional Web-based marketing techniques that require either drastic or time consuming analysis and manual adjustments to rendered content";

b) Langheinrich (6,654,725) discloses showing advertisements based on the success of prior displays of that advertisement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner
5/4/05